



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/253,793 02/22/99 ROBISON

J 4164-P

| EXAMINER |
|----------|
|----------|

QM02/0925

LLOYD W. SADLER OR DANIEL P. MCCARTHY
PARSONS BEHLE & LATIMER
201 SOUTH MAIN STREET, SUITE 1800
SALT LAKE CITY UT 84111-2218

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3754
DATE MAILED:

09/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/253,793

Applicant(s)
Robison et al.

Examiner
Eric Keasel

Art Unit
3754



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 11, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13 and 15-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 3754

DETAILED ACTION

Request for Continued Examination

1. The request for a continued prosecution application (CPA) under 37 CFR 1.53(d) filed on 11 August 2001 is acknowledged. 37 CFR 1.53(d)(1) was amended to provide that the prior application of a CPA must be: (1) a utility or plant application that was filed under 35 U.S.C. 111(a) before May 29, 2000, (2) a design application, or (3) the national stage of an international application that was filed under 35 U.S.C. 363 before May 29, 2000. *See Changes to Application Examination and Provisional Application Practice*, interim rule, 65 *Fed. Reg.* 14865, 14872 (Mar. 20, 2000), 1233 *Off. Gaz. Pat. Office* 47, 52 (Apr. 11, 2000). Since a CPA of this application is not permitted under 37 CFR 1.53(d)(1), the improper request for a CPA is being treated as a request for continued examination of this application under 37 CFR 1.114. *See id.* at 14866, 1233 *Off. Gaz. Pat. Office* at 48.

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 August 2001 has been entered.

Art Unit: 3754

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 13 and 15-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 13 recites “a plug head band is made of a material capable of plastic deformation”. However, the specification does not disclose anything relating to the plastic deformation property of the band material. Furthermore, applicant is arguing that many of the materials originally disclosed as acceptable for the band material are not capable of plastic deformation. Applicant can not change the original disclosure to limit the list of acceptable band materials to a subset of that list. This is a new matter rejection.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13, and 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3754

It appears that there are either extra words or missing words in claim 13, lines 3 and 4 (“means for holding further comprises a plug head band is made of a material capable of plastic deformation”).

Claim 19, line 2, recites “a band” which appears to be a double inclusion of “a plug head band” of claim 13, line 3. It is vague and indefinite as to whether there is one band or two bands.

Claim 19, line 3, recites “said band further comprises a material”. “[A] material” appears to be a double inclusion of “a material” of claim 13, lines 3 and 4. It is vague and indefinite as to whether the band is made of one material or two.

7. In light of the above informalities, the claims have been examined as could best be understood by the examiner. The examiner's failure to apply prior art to any of the claims should not be construed as an indication of allowable subject matter.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3754

9. Claims 13 and 15-20 (as understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Maier et al. in view of Szymaszek et al.

Maier et al. disclose a ceramic valve plug head (2), a valve plug stem (3), and a plug head band (4). The preferred materials for the band include aluminum titanate (an aluminum alloy). The band is in contact with the head and the stem.

The band of Maier et al. has a first side (engaging the head) greater in height than a second side (its top or bottom). However, applicant may intend that the second side be the side opposite the first side. Maier et al. do not show this. It would have been an obvious matter of design choice to have made the first side greater in height than the second (opposite) side, since applicant has not disclosed that doing so solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the ratio of the heights of the sides in any proportion as long as the friction fit between the retainer and the plug is great enough so that the retainer does not slip. In fact, Maier et al. use this friction as their means for fastening.

Maier et al. do not disclose means for fastening as a plurality of nuts and bolts or pins. Szymaszek et al. disclose a similar valve plug head (30), valve plug stem (20), and valve head plug retainer (42). Szymaszek et al. use a plurality a bolts threaded through the retainer and into the plug (obviating the need for nuts). The bolts are considered an equivalent of the pins. It would have been obvious to one having ordinary skill in the art at the time the invention was

Art Unit: 3754

made to have used the means for fastening of Szymaszek et al. in the invention of Maier et al. in order to secure the head, stem, and retainer as taught by Szymaszek et al.

Response to Arguments

10. Applicant's arguments filed 19 January 2001 have been fully considered but they are not persuasive.

Applicant has clearly disclosed and claimed the band materials in the originally presented claim 19. Applicant can not overcome the rejection by changing the list of acceptable materials or amending the claims to recite certain properties that some of the disclosed materials have and others do not have. This adds new matter to the application.

Conclusion


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (703) 308-6260.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver, can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7766.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

EK 21 SEP 01
ek

September 21, 2001


David A. Scherbel
Supervisory Patent Examiner
Group 3700